

Applicant : William E. Richeson
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REMARKS

The Examiner has made the Office Action final. In the Office Action, the Examiner indicated the allowance of claims 1-22, and rejected claims 32-34 and 36-48 under 35 U.S.C. § 103(a) as being unpatentable over Soileau et al. U.S. Patent No. 4,601,765. The Examiner also rejected claim 35 under 35 U.S.C. § 103(a) as being unpatentable over Soileau et al. '765 in view of Grove U.S. Patent No. 3,753,182.

I. THE FINALITY OF THE OFFICE ACTION IS IMPROPER

The Examiner has made the Office Action final. Second or subsequent actions on the merits may be made final, except where the Examiner introduces a new ground of rejection that is neither necessitated by the Applicant's amendment of the claims nor based on information submitted in an Information Disclosure Statement filed during the period set forth in 37 C.F.R. § 1.97(c). MPEP § 706.07(a).

In the previous Office Action mailed September 15, 2004, the Examiner did reject claims 32-48 under 35 U.S.C. § 103(a), but as being unpatentable over Grove U.S. Patent No. 3,753,182 in view of Soileau et al. U.S. Patent No. 4,601,765. In the present Office Action, claims 32-34 and 36-48 are rejected under § 103(a) over Soileau et al. '765 only. Claim 35 is rejected under § 103(a) as being unpatentable over Soileau et al. '765 in view of Grove '182. In fact, the Examiner states that with the respect to the rejection of claims 32-47 under § 103(a) that the Applicant's arguments had been considered and are persuasive. (See page 6 of present Office

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Action). Therefore, that rejection was withdrawn. The Examiner also states that a new ground of rejection is made in view of the prior art of record. (*Id.*)

Necessarily, because a new ground of rejection has been presented, the finality of the instant Office Action is not proper. MPEP § 706.07(a). Therefore, the Applicant respectfully respects that the finality of the instant Office Action be withdrawn.

II. § 103 REJECTIONS OF CLAIMS 32-48

The Examiner has rejected claims 32, 34, and 36-48 under § 103(a) as being unpatentable over Soileau et al. '765, and has rejected claim 35 under § 103(a) as being unpatentable over Soileau et al. '765 in view of Grove '182. Soileau et al. '765 is directed toward a transformer and inductor intended for discharge lamp ballast circuits. The Soileau et al. '765 transformer and inductor is not intended or designed to be frictionally engaged with another surface, such as the surface of a brake drum. Prior art references used in obviousness determinations must either be in the field of the inventor's endeavor or reasonably pertinent to the problems that the inventor solves. *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992); MPEP § 2141.01(a). Therefore, the Soileau et al. '765 reference is not analogous art and is not properly used in the determination of what one of ordinary skill in the art would have known or considered at the time of invention of the claims of the present application.

Furthermore, the Examiner has not met his burden because the cited prior art does not include all of the elements of the claims in the present application. In particular, the Soileau et al. '765 reference does not disclose a frictional material comprising a polymeric donor material.

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Though the Examiner has stated that certain aspects of the claimed invention of claims 32-48 would have been obvious to one of ordinary skill in the art at the time of invention, such as using a polymeric donor material or having a powder metal to a specific Young's modulus, the Examiner does not say why it would have been obvious. It is the Examiner's burden to show that the prior art reference or references has all of the recited elements of the claimed invention. In this case, the Examiner has not done so and therefore the § 103(a) rejection of the claims is improper. Therefore, the Applicant respectfully requests that the § 103 rejection of claims 32-48 be withdrawn.

CONCLUSION

The Applicant submits that the present application is in a condition for allowance, a notice of which is respectfully solicited.

Respectfully submitted,

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